



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,703	06/29/2001	Dhananjay V. Keskar	10559-499001 / P11791	9207

7590 05/31/2005

Crystal D Sayles
Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard Seventh Floor
Los Angeles, CA 90025

EXAMINER

CARTER, AARON W

ART UNIT	PAPER NUMBER
----------	--------------

2625

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,703

Applicant(s)

KESKAR ET AL.

Examiner

Aaron W. Carter

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/31/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to papers filed on 01/31/2005.

Response to Amendment

2. In response to applicant's amendment received on 01/24/2005, all requested changes to the claims have been entered.

Response to Arguments

3. Applicant's arguments filed 01/24/2005 have been fully considered but they are not persuasive, the rejections from the previous office action stand.

4. Applicants argue that the prior art of Lazzouni does not teach or fairly suggest a processor that receives an electronic image that includes a printed passage, identifies a corresponding passage in the electronic version of the page, and creates an electronic notation based on the received data and associated with the corresponding passage.

Examiner disagrees, Lazzouni discloses an electronic image that includes a printed passage in column 4, lines 10-14, column 5, lines 44-54 and column 8, lines 39-58. According to Merriam-Webster's dictionary a "passage" is something that happens or is done, an incident or can be a brief portion of written work, wherein written means to have scratched, drawn or inscribed. That said, the invention of Lazzouni inscribed a piece of paper with infrared ink in a prerecord pattern and then, as the piece of paper is marked by a user, an electronic image of a printed passage of the pattern is taken.

Art Unit: 2625

Lazzouni goes on to disclose that the processor identifies a corresponding passage in the electronic version of the page, and creates an electronic notation based on the received data and associated with the corresponding passage in column 4, lines 59-65, wherein the electronic image of the printed passage, as described above, is analyzed by the processor to determine the position of the corresponding passage of pixels in the in the prerecorded electronic version of the page, at which the an electronic notation of the handwritten notation is recorded.

5. Applicants argue that the prior art of Lazzouni does not teach or fairly suggest that the surface of a the printed page includes printed text corresponding to a part of the electronic version of the printed page.

Examiner disagrees, Lazzouni discloses an that the surface of a the printed page includes printed text corresponding to a part of the electronic version of the printed page in column 4, lines 10-14 and 44-54, column 5, lines 44-54 and column 8, lines 39-58. According to Merriam-Webster's dictionary "text" is something written or spoken considered as an object to be examined, and based on the definition of written from above, the surface of the page disclosed by Lazzouni can be said to contain on it printed text in the form of pixels that indicate a position on the page.

6. Applicants argue that the combination of Lazzouni and Leichner do not teach or fairly suggest the limitations of dependent claim 2.

Examiner disagrees, the prior art of Lazzouni discloses the invention of claim 1 while Leichner teaches the advantages of having a processor configured to identify the

Art Unit: 2625

electronic version of the page based on a received page identifier in a device that records hand written notations (column 1, lines 26-41, column 3, lines 35-49 and column 4, lines 28-33).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3, 6-8, 12-14, 17, 18-23 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,652,412 to Lazzouni et al. ("Lazzouni").

As to claim 1, Lazzouni discloses an apparatus comprising:

A memory storage unit to store an electronic version of a page (column 2, lines 38-41 and column 4, lines 43-50, wherein recording unit corresponds to memory storage unit); and

A processor coupled to the memory storage unit and configured to receive data associated with a handwritten notation applied to a printed page (column 6, lines 35-42) and an electronic image of an area of the printed version of the page near the notation (column 5, lines 44-54), the electronic image including a printed passage, to identify a corresponding passage in the electronic notation based on the received data and associated with the corresponding passage (column 4, lines 10-14, column 5, lines 44-54

Art Unit: 2625

and column 8, lines 39-58, column 2, lines 44-50, According to Merriam-Webster's dictionary a "passage" is something that happens or is done, an incident or can be a brief portion of written work, wherein written means to have scratched, drawn or inscribed. That said, the invention of Lazzouni inscribed a piece of paper with infrared ink in a prerecord pattern and then as the piece of paper is marked by a user, an electronic image of a printed passage of the pattern is taken. Lazzouni goes on to disclose that the processor identifies a corresponding passage in the electronic version of the page, and creates an electronic notation based on the received data and associated with the corresponding passage in column 4, lines 59-65, wherein the electronic image of the printed passage, as described above, is analyzed by the processor to determine the position of the corresponding passage of pixels in the in the prerecorded electronic version of the page, at which the an electronic notation of the handwritten notation is recorded.).

As to claim 3, Lazzouni discloses the apparatus of claim 1, wherein the processor is configured to identify a first portion of the electronic image that represents the area of the printed page (column 5, lines 57-59) and to identify a second portion of the electronic image that represents the handwritten notation (column 5, lines 59-63, see also column 6, lines 35-42).

As to claim 6, Lazzouni discloses the apparatus of claim 1, wherein the processor is configured to create a bitmap image based on the data associated with the handwritten notation and to identify a correlation with the corresponding passage of the electronic

Art Unit: 2625

version of the page (Figs. 12, 13 and column 11, lines 2-4, wherein the a Gray Code is used to encode each pixel in the bitmap according to pen movement in the X and Y directions).

As to claim 7, Lazzouni discloses the apparatus of claim 1, wherein the processor is configured to apply handwritten character recognition to transform the data associated with the handwritten notation into digital text and to identify a correlation between the digital text and the corresponding passage (Figs. 12, 13 and column 11, lines 2-4, wherein the a Gray Code is used to encode each pixel in the bitmap according to pen movement in the X and Y directions, thus taking the handwriting and creating a digital text).

As to claim 8, Lazzouni discloses a system comprising:

A computer comprising a processor and a memory storage device storing an electronic version of a printed page (column 2, lines 38-41 and column 4, lines 43-50, wherein recording unit corresponds to memory storage unit); and

A writing utensil to apply a notation to the printed page (column 5, lines 1-12 and Fig. 3), the writing utensil including a scanner positioned to scan a surface of the printed page as the notation is being applied to the printed page (Fig. 3, elements 50-70), the surface of the printed page including printed text corresponding to a part of the electronic version of the printed page (column 4, lines 10-14 and 44-54, column 5, lines 44-54 and column 8, lines 39-58. According to Merriam-Webster's dictionary "text" is something written or spoken considered as an object to be examined, and based on the definition of

Art Unit: 2625

written from above, the surface of the page disclosed by Lazzouni can be said to contain on it printed text in the form of pixels that indicate a position on the page);

Wherein the processor includes a port to receive from the writing utensil stroke data associated with a notation applied by the writing utensil (Fig. 7, column 3, lines 5-8 and column 6, lines 35-42) and an electronic image of an area of the printed page associated with the applied notation (column 5, lines 44-54), and is configured to create an electronic notation based on the stroke data and associated with the corresponding part of the electronic version of the printed page (Figs. 12, 13 and column 11, lines 2-4, wherein the a Gray Code is used to encode each pixel in the bitmap according to pen movement in the X and Y directions, thus creating electronic notation based on the stroke data).

As to claim 12, please refer to rejections made for claim 6 above.

As to claim 13, please refer to rejections made for claim 7 above.

As to claim 14, please refer to rejections made for claim 8 above.

As to claim 17, Lazzouni discloses the method of claim 14, wherein capturing the stroke data comprises utilizing an echo-location technique (column 6, lines 8-34).

As to claim 18, Lazzouni discloses the method of claim 14, wherein the page comprises grid marks and wherein capturing the stroke data comprises utilizing an image processing technique to track movement of the writing utensil on the grid marks (column 6, lines 35-45 and lines 61-65).

As to claim 19, please refer to rejections made for claim 6 above.

As to claim 20, please refer to rejections made for claim 7 above.

As to claim 21, Lazzouni discloses the method of claim 20, comprising creating a link between the digital text and the particular portion of the electronic version of the page (column 2, lines 38-59).

As to claim 22, Lazzouni discloses the method of claim 14, wherein correlating the captured stroke data with the particular portion of the electronic version of the page comprises employing a pattern recognition technique (column 6, lines 35-45 and lines 61-65).

As to claim 23, please refer to rejections made for claim 1 above.

As to claim 27, please refer to rejections made for claim 8 above.

As to claim 28, Lazzouni discloses the apparatus of claim 27, comprising a wireless transmitting device to transmit the image to a remote device (column 3, lines 7-8).

As to claim 29, Lazzouni discloses the apparatus of claim 27, comprising an adjustable power switch to enable a user to selectively disconnect a power source from the scanner (Fig. 7, element 144 and 146 and column 9, lines 28-38).

Art Unit: 2625

As to claim 30, Lazzouni discloses the apparatus of claim 27 comprising a conductive contact positioned to mate with an external adapter to transmit the image to a remote device (column 9, lines 14-27).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 4, 5, 9-11, 15, 16, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni in view of USPN 6,050,490 to Leichner et al. ("Leichner").

As to claim 2, Lazzouni discloses the apparatus of claim 1, he does not disclose expressly disclose wherein the processor is configured to identify the electronic version of the page based on a received page identifier.

However, Leichner discloses identifying the electronic version of a printed page based on a received page identifier (column 3, lines 35-49).

Lazzouni & Leichner are combinable because they are both in the same field of taking a printed page, making handwritten notations on it and creating an electronic version of the page along with the notations.

Art Unit: 2625

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add to the invention of Lazzouni the page identification process disclosed by Leichner.

The suggestion/motivation for doing so would have been that providing a page identifier allows a user to switch between multiple printed pages and still maintain an exact electronic copy (column 1, lines 26-41 and column 4, lines 28-33).

Therefore, it would have been obvious to combine the invention disclosed by Lazzouni with the invention of Leichner to obtain the invention as specified in claim 2.

As to claim 4, Lazzouni discloses the apparatus of claim 3, while Leichner further discloses wherein the processor is configured to apply optical character recognition to transform the first portion of the electronic image into digital text (column 2, lines 30-34 and column 4, lines 43-49).

As to claim 5, the combination of Lazzouni discloses the apparatus of claim 4, wherein Leichner further discloses wherein the processor is configured to identify the corresponding passage by searching the electronic version of the page for the digital text (column 4, lines 43-49, specifically lines 47-49).

As to claim 9, please refer to rejections made for claim 2 above.

As to claim 10, please refer to rejections made for claim 4 above.

As to claim 11, please refer to rejections made for claim 5 above.

As to claim 15, please refer to rejections made for claim 4 above.

Art Unit: 2625

As to claim 16, please refer to rejections made for claim 5 above.

As to claim 24, please refer to rejections made for claim 2 above.

As to claim 25, please refer to rejections made for claim 4 and 5 above.

As to claim 26, the combination of Lazzouni and Leichner discloses the article of claim 25, Leichner further discloses computer-executable instructions for causing the computer system to indicate a correlation between the data associated with the notation and the passage containing the digital text (column 4, lines 43-49).

Conclusion

12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

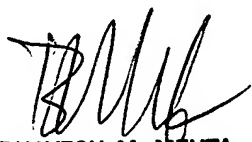
Art Unit: 2625

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron W. Carter whose telephone number is (571) 272-7445. The examiner can normally be reached on 8am - 4:30 am (Mon. - Fri.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

awc
AWC


BHAVESH M. MEHTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600